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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,746	02/10/2004	Christie M. Cox	P2702US	1553
8968 7590 04/13/2009 DRINKER BIDDLE & REATH LLP ATTN: PATENT DOCKET DEPT. 191 N. WACKER DRIVE, SUITE 3700 CHICAGO, IL 60606				
EXAMINER MILLER, WILLIAM L				
ART UNIT		PAPER NUMBER		
3677				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/775,746

Applicant(s)

COX ET AL.

Examiner

William L. Miller

Art Unit

3677

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 6 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6, 16-18, 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Claim 19 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse as documented in paragraph 6 of the Office action dated 09-14-2005.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 4, 6, 16-18, and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pazar (US#2003/0167706) in view of Takemoto et al. (US#4219596).

4. Regarding claim 1, Pazar discloses a decorative carapace for a burial vault comprising: a carapace 2910 (Fig. 28) having a top surface; and a metal substrate (nameplate) 2310 having a decorative graphic (name and date) and being attached/adhered to the top surface via screws.

5. Regarding claims 1, 3, 4, and 6, Pazar fails to disclose the substrate as being a transparent substrate having a decorative graphic printed thereon wherein the substrate is attached to the carapace via a transparent adhesive. Takemoto discloses a decorative assembly comprising a transparent substrate 16 having a decorative graphic 18 printed thereon wherein the substrate is attached to a structure via a transparent adhesive (col. 3, lines 59-60) such that the graphic appears to be part of the structure as opposed to appearing “stuck on” (col. 3, lines 57-62). Therefore, as evidenced by Takemoto, it would have been obvious to one of ordinary skill in the

art at the time the invention was made to modify Pazar by replacing the metal substrate with a transparent substrate having a decorative graphic printed thereon wherein the substrate was attached to the carapace via a transparent adhesive. The rationale for supporting this conclusion of obviousness is the proposed combination is based upon a simple substitution of one known element for another to obtain predictable results (MPEP 2143 and *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007)). The substitution of the metal substrate with a transparent substrate having a decorative graphic printed thereon wherein the substrate was attached to the carapace via a transparent adhesive would improve the appearance of the vault as the graphic would appear to be part of the structure.

6. Further regarding claim 1, Takemoto teaches the substrate can include acrylated polyester resins (col. 4, line 49).

7. Regarding claims 16 and 18, Pazar discloses a decorative receptacle for holding the remains of a deceased, the receptacle comprising: a container being collectively viewed as the burial vault and its carapace 2910 (Fig. 28); and a metal substrate (nameplate) 2310 having first (upper) and second (lower) sides; the substrate having a graphic image (name and date) on its first side and being attached/adhered at its second side to a first surface (upper surface of carapace) of the container via screws.

8. Regarding claims 16, 20, and 22, Pazar fails to disclose the substrate as being a transparent substrate having a graphic image printed thereon wherein the substrate is attached to the first surface (upper surface of the carapace) of the container via a transparent adhesive. Takemoto discloses a decorative assembly comprising a transparent substrate 16 having a graphic image 18 printed thereon wherein the substrate is attached to a structure via a transparent

adhesive (col. 3, lines 59-60) such that the graphic appears to be part of the structure as opposed to appearing “stuck on” (col. 3, lines 57-62). Therefore, as evidenced by Takemoto, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pazar by replacing the metal substrate with a transparent substrate having a decorative graphic printed thereon wherein the substrate was attached to the carapace via a transparent adhesive. The rationale for supporting this conclusion of obviousness is the proposed combination is based upon a simple substitution of one known element for another to obtain predictable results (MPEP 2143 and *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007)). The substitution of the metal substrate with a transparent substrate having a decorative graphic printed thereon wherein the substrate was attached to the carapace via a transparent adhesive would improve the appearance of the vault as the graphic would appear to be part of the structure.

9. Regarding claim 17, see above analysis of claim 16. Although Pazar as modified by Takemoto fails to specifically disclose the substrate being sized to substantially cover the first surface (upper surface of the carapace) of the container, it would have been an obvious design consideration to further modify the substrate such that it was sized to substantially cover the first surface (upper surface of the carapace) of the container as a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

10. Regarding claim 21, the graphic image 18 taught by Takemoto is colored as it is composed of conventional inks (col. 5, lines 29-30).

11. Regarding claims 23 and 24, the substrate 16 taught by Takemoto is "substantially rigid" as it is a solid, cured, polymeric material (col. 4, lines 1-10), and this solid, cured, polymeric material is a continuous sheet of material without seams.
12. Regarding claim 25, Takemoto teaches an overcoating over the indicia (graphic image) 18 which provides a protective layer covering the graphic image.

Response to Arguments

13. The applicant argues the following:
14. "One of ordinary skill in the art would not seek to combine Pazar, teaching a durable identification nameplate, with Takemoto, teaching a transparent film decorative label to arrive at the invention claimed by independent claims 1, 16, and 17. The unpredictable results are not results, as asserted by the Examiner, of the appearance improvement of the carapace, but rather the enhancement of commercial viability of a carapace that has a very limited viewability by the purchasers."
15. The examiner disagrees as there is nothing unpredictable about modifying Pazar in view of Takemoto, namely replacing a known display substrate (Pazar, metal substrate with graphics) with another known display substrate (Takemoto, transparent substrate with graphics). In response to the applicant's argument that the applicant uses the transparent substrate for commercial desirability versus the examiner's statement that the simple substitution per *KSR* would enhance the appearance of the vault, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).
16. The applicant argues the following:

17. "The revised declaration of Marty Jay Cox demonstrates the non-obviousness of the present invention by demonstrating commercial success of the invention. The evidence of actual market sales figures demonstrating increased market share negates the need to separately provide evidence as to expected market sales figures over a time period."

18. The revised affidavit of Marty Cox filed under 37 CFR 1.132 on 07-08-2008 is insufficient to overcome the rejection of claims 1, 3, 4, 6, 16-18, and 20-25 based upon the 35 U.S.C. 103 rejection of Pazar in view of Takemoto as set forth in the current Office action because of the following: The provided gross sales figures and evidence as to market share is insufficient to effectively establish commercial success as there is no means (data) to evaluate the increase in market share versus the industry, such as expected sales data.

Conclusion

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is (571) 272-7068. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on (571) 272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William L. Miller/
Primary Examiner, Art Unit 3677